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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,351	10/06/2004	Ernest R. Bodnar	1120U106	9530
George Rolston 45 Sheppard Avenue East Suite 900 Toronto, ON M2N 5W9 CANADA				
7590 11/24/2009			EXAMINER	
			CAJILIG, CHRISTINE T	
			ART UNIT	PAPER NUMBER
			3633	
			MAIL DATE	DELIVERY MODE
			11/24/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/510,351

Applicant(s)

BODNAR, ERNEST R.

Examiner

CHRISTINE T. CAJILIG

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009 and 04 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-7, 26, 28 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 26, 28 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-7, 26, 28, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodnar (U.S. Patent No. 4,793,113).

Regarding claims 1, 7, 26, 28, and 37, Bodnar discloses a steel member for use in supporting structures and having reduced heat transfer characteristics as compared

with solid web studs, and comprising a web (28/30) defining side edges and an axis; a flange (26) on at least one side edge; web openings through said web at spaced intervals therealong, of predetermined size and profile, at least a side portion (44) of said web being removed from said opening and remaining attached integrally to said web and being bent away from said web along axes parallel to said web axis; struts (36) extending across said web between said openings and defining two ends; depressions (56/58) formed in said web at spaced intervals, at opposite ends of said struts.

Bodnar does not disclose openings in the form of slots formed in said depressions to reduce heat transfer.

Oberg discloses openings (2) formed in depressions (4), wherein the openings correspond with the shape of the depression to provide a lightweight yet rigid structure.

It would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify the structure of Bodnar to have openings matching the elongated shape of the depressions as taught by Oberg to provide a structure having a predictable result of being lightweight yet rigid.

The method steps of making a steel member as recited in claims 26, 28, and 37 would have been obvious method steps in making the structure set forth above.

Regarding claim 4, Bodnar modified by Oberg further discloses that said web openings are of a shape defining a linear side edge (44) and an arcuate side edge (42), said side portion of said web being integral with said linear edge.

Regarding claim 5, Bodnar modified by Oberg further discloses that there are two said flanges (24, 26) one on each side of said web, being formed normal to said web, and lips (34) formed along said flanges, normal to said flanges.

Regarding claim 6 Bodnar modified by Oberg further discloses that said web openings are arranged in an alternating orientation and defining between them struts extending diagonally across said steel member.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bodnar in view of Oberg as applied to claim 1 above, and further in view of Schnitzer (U.S. Patent No. 1,656,871).

Regarding claim 3, Bodnar modified by Oberg discloses the structure discussed above but does not disclose that the side portion defines a channel shape extending along an axis parallel to said web.

Schnitzer in Figure 8 discloses a web with side portions formed out of said web and defining a channel shape extending along an axis parallel to said web.

It would have been obvious to a person having ordinary skill in the arts at the time of the Applicant's invention to modify the structure of Bodnar modified by Oberg to have the side portions define a channel shape extending along an axis parallel to said web as taught by Schnitzer to provide the predictable result of imparting increased rigidity to the web.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-7, 26, 28, and 37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHRISTINE T. CAJILIG** whose telephone number is (571) 272-8143. The examiner can normally be reached on Monday-Thursday, 9 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571) 272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. T. C./
Examiner, Art Unit 3633

/Robert J Canfield/
for D. Dunn, SPE of Art Unit 3633